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EXAMINER

PHAN, JOSEPH T

ART UNIT PAPER NUMBER

2645

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/974,957

Applicant(s)

KUSHITA, MASAYUKI

Examiner

Joseph T. Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6,9,10,16 and 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,9,10,16 and 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-10, 19-20, 23, and 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 line 18, claim 10 line 19, claim 19 line 22, claim 20 line 25, claim 23 line 19, and claim 27 line 23 recites the phrase *"while retaining the call"*. It is unclear and confusing if "the call" refers to the same call as in lines 10-11 which was previously terminated. If the steps *"retrieving text data stored in memory"* in lines 6 and 17 was both performed on the same call, then the claims have enablement issues as the specification does not teach steps of "retrieving another item of text data" after the call was terminated. The issue of retrieving text data twice during one or multiple calls is significant to the embodiment and bounds of the claims thus rendering the claims indefinite.

Similar error is recited in the step of "designating reproduction of the text data" as the language in the step refer back to antecedent language steps recited prior to terminating the call thus rendering the claims indefinite. Appropriate correction is required.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 05/27/05 fails to comply with the

Art Unit: 2645

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because an English translation of the documents or a full concise explanation of the relevance was not provided.

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 6,9,10, 16, and 19-30 rejected under 35 U.S.C. 102(e) as being anticipated by Everett, Patent #6,701,162.**

Regarding claim 6, Everett teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the party being called as claimed in claim 9, wherein contents of the text data are displayed on a display during the transmission (col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8).

Art Unit: 2645

**Regarding claims 9 and 10,** Everett teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of a party being called comprising the steps of:

receiving a signal sent from a base station corresponding to a response of the called party to a call setup operation from a key-input section of a cellular phone(*cellular phones connects and performs transmission after the called party answers*); retrieving text data stored in a memory converting the text data into audio data at a text-to-speech converter; transmitting the converted audio data to the called part via a radio transmitter/receiver(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8); displaying contents of the text data on a display during the transmission(col.2 lines 55-65); automatically terminating the call or disconnecting after the transmission of the audio data is completed(*Everett's user disconnects after transmission is completed*), designating reproduction of the text data during a prescribed period of time after the cellular

phone receives a connection signals from the base station in response to an answer by the called party; indicating completion of the transmission on the display after the transmission of the converted audio data is finished(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8; *cellular phones display 'ended' after completion*);

retrieving another item of text data stored in the memory and supplying the text data to the text-to-speech converter while retaining the call; converting the text data into audio data at the text-to-speech converter for transmittal to the called party continuously; and sending the converted audio data to the radio transmitter/receiver in succession(col.2

Art Unit: 2645

line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47; two-way radios performs multiple transmissions on the same call).

**Regarding claims 16 and 19-22 Everett** teaches as best understood due to the 112 confusion above, a cellular phone comprising:

a key-input section for inputting a telephone number when making a phone call, a text-entry and settings for respective functions;

a radio transmitter/receiver for communicating with a base station by radio;

memories for storing inputted character data as text data;

a text-to-speech converter for converting the text data into audio data;

a controller which includes: a means for originating a call of a telephone number when the telephone number and a call up setup are inputted from the key-input section,

a means for retrieving the text data stored in one of the memories on receipt of

a signal sent from the base station corresponding to a response of a called party to the call and supplying the text data to the text-to-speech converter in order to convert the

text data to audio data, a means for sending the converted audio data to the radio transmitter/receiver, and a means for terminating the call or disconnecting after the

transmission of the converted audio data is completed;

a means for designating reproduction of the text data during a prescribed period of time after the cellular phone receives a connection signal from the base station in response to an answer by the called party;

either/both of the memories store plural items of text data; and

the controller further includes a means for indicating completion of transmission

Art Unit: 2645

on the display every time one of the plural items of text data has been converted into audio data and transmitted, a means for retrieving another item of text data stored in one of the memories while retaining the call and supplying the text data to the text-to-speech converter in order to convert the text data to audio data, and a means for continuously sending the converted audio data to the radio transmitter/receiver(Fig.1, col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47).

Regarding claim 23, Everett teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up, comprising the steps of: receiving a signal sent from a base station corresponding to a response of the other party to a call setup operation from a key-input section of a cellular phone; retrieving text data stored in a memory; converting the text data into audio data at a text-to-speech converter in the cellular phone(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47); transmitting the converted audio data to the other party via a radio transmitter/receiver', and automatically terminating the call or disconnecting after the transmission of the audio data is completed(*col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47; Everett's user disconnects after completion*).

Regarding claim 24, Everett teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 23, wherein contents of the text data are displayed on a display during the transmission(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47).

Regarding claim 25, Everett teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 23, wherein the reproduction of the text data can be designated during the call including the point of time of reception(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47).

Regarding claim 26, Everett teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 24, wherein the reproduction of the text data can be designated during the call including the point of time of reception(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47).

Regarding claim 27, Everett teaches a cellular phone comprising:  
a key-input section for inputting a telephone number when making a phone call, a text-entry and settings for respective functions;  
a radio transmitter/receiver for communicating with a base station by radio;  
memories for storing inputted character data as text data;  
a text-to-speech converter for converting the text data into audio data in the cellular phone(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47; also see explanation from claim 9 above); and a controller which includes: a means for originating a call of a telephone number when the telephone number and a call up setup are inputted from the key-input section, a means for retrieving the text data stored in one of the memories on receipt of a signal sent from the base station corresponding to a response of the other party to the call and supplying the text data to the text-to-speech

Art Unit: 2645

converter in order to convert the text data to audio data, a means for sending the converted audio data to the radio transmitter/receiver, and a means for terminating the call or disconnecting after the transmission of the converted audio data is completed(*col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47; also see explanation from claim 9 above*);

a means for designating reproduction of the text data during a prescribed period of time after the cellular phone receives a connection signal from the base station in response to an answer by the called party:

either/both of the memories store plural items of text data; and

the controller further includes: a means for indicating completion of transmission on the display every time one of the plural items of text data has been converted into audio data and transmitted. a means for retrieving another item of text data stored in one of the memories while retaining the call and supplying the text data to the text-to-speech converter in order to convert the text data to audio data and a means for continuously sending the converted audio data to the radio transmitter/receiver(*col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47*).

Regarding claim 28, Everett teaches a cellular phone as claimed in claim 27, further including a means for displaying contents of the text data on a display during the transmission(*col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47; also see explanation from claim 9 above*).

Regarding claim 29, Everett teaches a cellular phone as claimed in claim 27, further including a means for designating the reproduction of the text data during the call

Art Unit: 2645

including the point of time of reception(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47; also see explanation from claim 9 above).

Regarding claim 30, Everett teaches a cellular phone as claimed in claim 28, further including a means for designating the reproduction of the text data during the call including the point of time of reception(col.2 line 18-col.3 line 20 and col.3 line 62-col.4 line 8 and col.4 lines 39-47; also see explanation from claim 9 above).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims **6,9,10, 16, and 19-30** have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2645


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP

August 18, 2005



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